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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91120453
Party	Plaintiff HEARST COMMUNICATIONS, INC. and Hearst Magazines Property, Inc.
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Attachments	Opposers' Responses and Objections to Applicant's Written Cross-Examination.pdf (30 pages)(1544080 bytes)

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Hearst Communications, Inc. and)	
Hearst Magazines Property, Inc.,)	
)	
Opposers,)	
)	Opposition No. 91120453
v.)	
)	
Charles Browning Wilson,)	
)	
Applicant.)	

**OPPOSERS' RESPONSES AND OBJECTIONS
TO APPLICANT'S WRITTEN CROSS-EXAMINATION**

Opposers Hearst Communications, Inc. (HCI) and Hearst Magazines Property, Inc. (HMPI) submit the following responses and objections to Applicant's written cross-examination:

OBJECTIONS

Opposers object to the definition of "Opposers' Mark" as unduly restrictive on the grounds that the mark underlying Reg. No. 1843656 is only one of two registrations asserted by Opposers in this litigation (the other is Reg. No. 0630028) and that the Opposers' Notice of Opposition additionally references Opposers' common law rights in various other marks.

Opposers object to the definition of "Applicant's Mark" as unduly broad on the ground that the definition does not restrict the referenced marks with regard to Applicant's goods and services; as argumentative on the ground that it asserts COSMO, COSMO.COM, and "any mark similar thereto used by Applicant" are Applicant's marks; and as inaccurate on the ground that Applicant claims it is the owner of the marks COSMO, COSMO.COM, and any mark similar thereto used by Applicant.

Opposers object to Applicant's Written Cross-Examination questions in their entirety and to each question to the extent that the information sought is protected by the attorney-client privilege or the work product doctrine or would disclose the mental impressions, conclusions, opinions, or legal theories of counsel and, as such, are protected.

Opposers object to Applicant's Written Cross-Examination questions in their entirety and to each question to the extent that they attempt to impose obligations upon Opposers inconsistent with or greater than the Federal Rules of Civil Procedure or the Trademark Rules of Practice.

Opposers object to Applicant's Written Cross-Examination questions in their entirety and to each question to the extent that they seek disclosure of confidential or proprietary business information or trade secrets of Opposers.

To the extent that Applicant's Written Cross-Examination questions are unlimited in time, Opposers object that the requests are overbroad and unduly burdensome or seek information not within the possession, custody, or control of Opposers.

To the extent that Applicant's Written Cross-Examination questions seek information regarding activity outside the United States, Opposers object on the ground that such information is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. The parties' claims arise solely out of the trademark laws of the United States, and extraterritorial activities are irrelevant to those claims.

By responding to Applicant's Written Cross-Examination questions, Opposers do not waive or intend to waive, but instead preserve, all objections as to the competency, relevancy, materiality, and admissibility of the responses or the subject matter thereof.

Opposers reserve the right to supplement or amend these responses based upon later recollections, the recollections of persons presently unidentified or unavailable, or the discovery of additional documents or information.

OPPOSERS' RESPONSES TO APPLICANT'S QUESTIONS TO OPPOSERS

Questions Nos. 1-4: There are no questions numbered 1-4 in Applicant's written cross-examination.

Question No. 5: Identify all Opposers' Goods and Services that currently use the exact name or designation "COSMO," listing the years during which such Opposers' Goods and Services were first used under such name and/or designation.

Response: As reflected in the documentary evidence accompanying the First Declaration of Stephen Rodgers, the public frequently refers to HCI's *Cosmopolitan* magazine using the abbreviated COSMO mark – indeed, the current definition of "Cosmopolitan" found in the on-line encyclopedia Wikipedia refers to "Cosmo Magazine." Although HCI has been unable to determine the earliest possible such use, such third party uses occurred as early as 1974 and extend to the present time. Attached as Exhibit A are abstracts of representative examples of third party articles published in 1974 referring to *Cosmopolitan* magazine as COSMO. In addition, HCI itself has used the COSMO mark as a reference to its *Cosmopolitan* magazine and departments or sections contained therein since at least as early as April 1964. Attached as Exhibit B are copies of the cover of the April 1964 *Cosmopolitan* magazine and Contents page, which lists "Cosmo Shopper" as one of the sections in the magazine. Attached as Exhibit C are copies of *Cosmopolitan* magazine covers and contents pages confirming the continued and present use of the COSMO mark by HCI. In addition, HCI provides online content under the COSMO mark standing alone at www.cosmopolitan.com and

at www.cosmomag.com, at which it also markets publications under the COSMO mark such as *The Cosmo Kama Sutra*. Attached as Exhibit D is a September 6, 2006 printout from the web site associated with the domain www.cosmopolitan.com showing use of the COSMO mark including in connection with the following sections, titles, and uses: COSMO QUIZ, COSMO QUIZZES, COSMO FAQs, COSMO KAMA SUTRA, COSMO FASHION, CONNECT WITH COSMO, BE IN COSMO, FREE STUFF FROM COSMO, COSMO EXCLUSIVES, COSMO FOR YOUR GUY, GET COSMO HEADLINES, CONFESS TO COSMO, MAKE COSMO YOUR HOMEPAGE, TELL COSMO ABOUT YOUR HAIR!, HELP COSMO CHOOSE ITS COVERLINES, MAKE A GREAT RECIPE FROM COSMO RADIO, SPORTING A STYLE YOU FOUND IN COSMO?, ADD COSMO TO YOUR MYSPACE, GET COSMO UPDATES, COSMO MOBILE, COSMO RADIO, FREE STUFF FROM COSMO, COSMO PROMO HOT SPOT, COSMO MEDIA KIT, and EVERYTHING COSMO. Attached as Exhibit E are printouts from www.archive.org showing use of the COSMO mark on Opposers' web site located at www.cosmomag.com.

Opposers also have used the COSMO mark in connection with advertising and promoting special events associated with or endorsed by Opposers. Attached as Exhibit F are copies of invitations, advertising, marketing, and promotional materials featuring the COSMO mark in connection with these events.

Question No. 6: Identify all Opposers' Goods and Services that formerly used the exact name or designation "COSMO," listing the years during which such Opposers' Goods and Services first used such name or designation.

Response: Opposers refer Applicant to their response to the previous question. Opposers additionally state that HCI used the COSMO mark in connection with the goods re-

cited in Reg. No. 1843656, namely cosmetic bags sold empty, umbrellas, leather key fobs, key cases, credit card holders and traveling bags, beginning in 1993.

Question No. 7: Identify the last use of Opposers' Mark in commerce.

Response: Opposers reiterate the objection to the definition of "Opposers' Mark" set forth above. Subject to this objection, Opposers continue to use the marks COSMO, COSMOPOLITAN, and variations thereof, and refer Applicant to their response to Question No. 5. Opposers are unable to identify the last use in commerce of the mark shown in Reg. No. 1843656 in connection with the goods covered by the referenced registration.

Question No. 8: Explain the basis for failing to file a renewal of Opposers' Mark pursuant to Section 8 of the Lanham Act, and the subsequent cancellation of such mark by the PTO on July 13, 2001.

Response: Opposers reiterate the objection to the definition of "Opposers' Mark" set forth above. Opposers additionally object to the characterization of the filing of a Section 8 declaration as a "renewal" and to the reference in the question to the "cancellation of such mark," rather than to the cancellation of the registration referenced in Applicant's definitions. Subject to these and the General Objections, at this time Opposers cannot identify the reason a Section 8 declaration was not filed for Reg. No. 1843656.

Question No. 9: Explain how Applicant's Mark conflicts with Opposers' Mark despite the cancellation and/or abandonment of such mark by Opposers.

Response: Opposers reiterate the objection to the definition of "Opposers' Mark" set forth above. Opposers also object to the suggestion underlying this question that HCI has abandoned its rights to the COSMOPOLITAN, COSMO, COSMO GIRL, COSMOPOLITAN.COM, COSMO SHOPPING, COSMO QUIZ, COSMO SURVEYS, and COSMO EXCLUSIVE marks described in the Notice of Opposition and in the First Declaration of

Stephen Rodgers. In light of the current nonuse of the mark underlying Reg. No. 1843656 in connection with the goods recited in that registration, however, Opposers do not maintain that there is a likelihood of confusion between that mark for those goods and Applicant's Mark.

Question No. 10: Explain how Applicant's Mark conflicts with any other mark which is not registered with the PTO, and which is owned by Opposers.

Response: As documented in the First Rodgers Declaration, HCI enjoys protectable trademark rights to the unregistered COSMO SHOPPING, COSMO QUIZ, COSMO SURVEYS, and COSMO EXCLUSIVE marks in connection with features of its *Cosmopolitan* magazine. HCI also routinely uses the unregistered COSMO mark standing alone both to describe HCI's *Cosmopolitan* magazine and to market other publications. Applicant's Mark is confusingly similar to these unregistered marks because the salient component of Applicant's Mark is identical to HCI's COSMO mark and to the salient elements of the remaining marks listed above. As reflected in the documentary evidence of actual confusion produced by Applicant itself, consumers viewing Applicant's Mark and correctly assuming that it corresponds to a domain name are likely to believe that the domain name is one used by HCI to provide the online version of HCI's magazine and the features of HCI's magazines provided under the COSMO SHOPPING, COSMO QUIZ, COSMO SURVEYS, and COSMO EXCLUSIVE marks.

Question No. 11: Explain how Applicant's Mark conflicts with Opposers' various registered trademarks for the phrase "COSMOPOLITAN."

Response: As reflected in the substantial evidence of actual confusion produced by Applicant itself, consumers viewing Applicant's Mark and correctly assuming that it corresponds to a domain name are likely to believe that the domain name is one used by HCI to

provide online content from the magazine sold under HCI's registered COSMOPOLITAN mark. Because of the public's tendency to view COSMOPOLITAN and COSMO as equivalents, Applicant's Mark not only is likely to be confused with Opposers' COSMO mark but also is equally likely to be confused with HCI's registered COSMOPOLITAN.COM mark. This likelihood of confusion is exacerbated by consumers' awareness of HCI's family of the other registered COSMO GIRL and COSMOPOLITAN marks described in the First Rodgers Declaration, which entitles HCI to an expanded scope of protection for its marks.

Question No. 12: Explain how Applicant's Mark conflicts with any other registered mark owned by Opposers (except those marks owned by Opposers which are identified in questions 5, 6 and 7).

Response: Opposers state that there are no additional registered marks in dispute other than identified in response to questions 5, 6, and 7 and in the First Rodgers Declaration.

Question No. 13: Describe in detail all of Opposers' efforts to prevent Applicant's use of Applicant's Mark prior to Opposers' filing of their Notice of Opposition with the Trademark Trial and Appeal Board.

Response: Opposers object to this question on the ground that any objection Opposers may have to the *use* of Applicant's Mark is not relevant to this proceeding, in which the *registration* of that mark is at issue. Subject to this and the General Objections, Opposers have not taken any actions responsive to this question.

Question No. 14: If the answer to 9 is 'none' or similar negative designation, please describe the basis for such failure in light of Opposers' knowledge of Applicant's Mark and other third-parties use of 'cosmo.com', as demonstrated by the article published by ZDNet.com, dated November 25, 1996, (a copy of which has previously been produced to Opposers during discovery) in which a Ms. Bonnie Fuller' therein identified as an employee of Opposers, indicates that 'the matter has been referred to [Opposers] attorneys'.

Response: Opposers object to this question on the ground that any objection Opposers may have to the *use* of Applicant's Mark is not relevant to this proceeding in which only

the *registration* of that mark is at issue. Subject to this and the General Objections, Opposers were unaware of any trademark or service mark use in commerce of COSMO.COM during the referenced time frame that could have been challenged by Opposers under the Lanham Act's statutory causes of action. Opposers did timely oppose Applicant's application once that application was published for opposition, however, and therefore cannot be charged with any unreasonable delay.

Question No. 15: Explain the basis for the selection and adoption of the mark or designation 'COSMO' as used in Opposers Goods and Services.

Response: As the first use of COSMOPOLITAN as a mark for a magazine by HCI's predecessors in interest first took place in the nineteenth century, Opposers are unable to provide responsive information as to that mark. As to the remaining marks identified in Opposers' testimony, however, Opposers' selection of the marks was intended to leverage the fame and distinctiveness of the COSMOPOLITAN mark for magazines.

Question No. 16: Identify the First use of the designation 'COSMO' by Opposers.

Response: As set forth above, HCI enjoys priority of rights to the COSMO mark as a result of the widespread tendency of the public to abbreviate HCI's COSMOPOLITAN mark to COSMO. Although HCI is unaware of the earliest date on which such an abbreviation occurred, it has documented uses of the COSMO mark that refer to its magazine occurring at least as early as 1964.

Question No. 17: Identify whether Opposers have abandoned all use of Opposers' Mark. If no, explain the basis of same in light of Opposers' failure to file a renewal as required by Section 8 of the Lanham Act.

Response: Opposers reiterate the objection to the definition of "Opposers' Mark" set forth above. Opposers additionally object to the characterization of the filing of a Section 8

declaration as a “renewal.” Subject to these and the General Objections, at this time Opposers cannot identify the reason a Section 8 declaration was not filed for Reg. No. 1843656. However, the fact that a Section 8 declaration was not filed for Reg. No. 1843656 does not in and of itself represent an abandonment of the underlying mark as abandonment is defined by 15 U.S.C. § 1127.

Question No. 18: Identify all examples of actual use in commerce of Opposers’ Mark on or after July 13, 2001.

Response: Opposers reiterate the objection to the definition of “Opposers’ Mark” set forth above. Subject to these and the General Objections, Opposers refer Applicant to their response to Question No. 5.

Question No. 19: Identify any and all packaging, labels, advertising, marketing, promotional and published material bearing the designation COSMO in connection with each type of Good and/or Service (including, but not limited to, Opposers’ Goods and Services) offered for sale and/or sold by Opposers under the designation COSMO.

Response: Subject to the General Objections, representative examples of responsive items are attached as Exhibit G. Opposers additionally refer Applicant to the uses of the COSMOPOLITAN mark contained in Opposers’ First and Second Notices of Reliance.

Question No. 20: Identify any and all media outlets through or by which Opposers has advertised, promoted, published and/or marketed its goods and/or services under the specific designation ‘COSMO’.

Response: Opposers object to this question to the extent that it is meant to suggest that Opposers necessarily must have promoted goods and services “under the specific designation ‘COSMO’” to establish rights to the COSMO mark standing alone. Subject to this and the General Objections, Opposers state that HCI routinely uses its COSMO mark standing alone to promote HCI’s *Cosmopolitan* magazine through *Cosmopolitan* magazine itself,

Internet advertising, and advertising and promoting special events associated with or endorsed by Opposers.

Question No. 21: Identify any and all media through or by which Opposers have advertised, promoted, published and/or marketed its goods and/or services in connection with Opposers' Mark since FY 2000.

Response: Opposers reiterate the objection to the definition of "Opposers' Mark" set forth above. Opposers further object to this question to the extent that it implies that Opposers necessarily must have promoted goods and services under the COSMO mark to establish rights to the COSMO mark standing alone. Subject to these and the General Objections, Opposers state that HCI routinely uses its COSMO mark standing alone to promote HCI's *Cosmopolitan* magazine through *Cosmopolitan* magazine itself, Internet advertising, and advertising and promoting special events associated with or endorsed by Opposers. There has been no promotion of the mark underlying Reg. No. 1843656 in connection with the goods covered by that registration since fiscal year 2000.

Question No. 22: Identify all the customers to whom Opposers has sold or distributed products and/or services (including, but not limited to, Opposers' Goods and Services) under the designation COSMO; for the purposes of this question, "customers" shall not mean individual consumers of Opposers' Goods and/or Services (i.e., the individual purchasers of Opposers' Products) but shall mean each and every distributor, vendor, retail location, wholesale outlet, store, mail order house or establishment, Internet based outlet or other venue, for the sale or offer of sale of Opposers' Goods or Services or offered for sale under the specific designation 'COSMO'.

Response: Opposers object to this question on the ground that it is overly burdensome and seeks information not relevant to this litigation. Subject to this and the General Objections, Opposers stipulate that they will not seek to identify each such customer individually as part of their prima facie case. Rather, Opposers state that they currently provide

Cosmopolitan magazine through the following general channels of distribution: (1) news stand; (2) subscription; and (3) the Internet.

Question No. 23: Identify and describe all efforts by Opposers since on or after FY 1995 to prevent any and all third-parties from using: (I) the designation ‘COSMO’, (II) the uniform resource locator www.cosmo.com and/or (III) Opposers’ Mark.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Subject to this and the General Objections, Opposers state that they have not yet undertaken any responsive actions to stop the use of the www.cosmo.com URL or to enforce rights to the mark underlying Reg. No. 1843656. With respect to third party use of the designation “COSMO,” Opposer HCI in 2005 successfully challenged the use of the mark COSMO GIRL MODEL by a modeling agency in Maywood, New Jersey.

Question No. 24: Identify and describe all efforts by Opposers to prevent the entity known as Kozmo.com, Inc., 80 Broad Street New York NEW YORK 10004 from using and/or registering the mark ‘KOZMO COM’ under U.S. trademark registration No. 2544167. If none, please explain the basis for such decision.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use, especially because the referenced registration has been cancelled. Subject to these and the General Objections, Opposers have not taken any responsive action because, to the best of Opposers’ knowledge, the mark currently is not in use. In addition, to Opposers’ knowledge, the public does not abbreviate HCI’s COSMOPOLITAN mark to KOZMO. The mark underlying the registration also incorporates a prominent design element further distinguishing the mark from Opposers’ marks. Moreover, as the registration already has been cancelled, there is no action for Opposers to take.

Question No. 25: Identify and describe all efforts by Opposers to prevent the entity known as Cosmo Corporation, 30201 Aurora Road, Cleveland OH 44139, from using and/or registering the mark 'COSMO' under U.S. trademark registration Nos. 3035236 and 3035237, and said entities pending trademark applications under serial Nos. 78667292 and 78667304. If none, please explain the basis Opposers decision to ignore such use in each particular instance.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registrations are not evidence that the underlying marks actually are in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registrations cover underlying marks that do not include the .com suffix. The underlying marks therefore do not inherently communicate to consumers familiar with HCI's *Cosmopolitan* magazine, the abbreviation of HCI's COSMOPOLITAN mark to COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying marks have a corresponding website at which HCI's online content may be accessed. In addition, the registrations and applications referenced in Question No. 25 cover parts and services in the electrical and industrial fields, which are different from the goods and services offered by Opposer.

Question No. 26: Identify and describe all efforts by Opposers to prevent the entity known as Trek Bicycle Corporation, 801 West Madison St Waterloo WI 53594, from using and/or registering the mark 'COSMO' under U.S. PTO registration No. 2576084. If none, please explain the basis Opposers decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with

HCI's *Cosmopolitan* magazine, the abbreviation of HCI's COSMOPOLITAN mark to COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI's online content may be accessed. In addition, the registration referenced in Question No. 26 covers bicycles and bicycle parts, which are different from the goods and services offered by Opposer.

Question No. 27: Identify and describe all efforts by Opposers to prevent the entity known as Antista Fairclough Design, Ltd. II, Sixty Four Lenox Pointe, NE Atlanta GA 30324, from using and/or registering the mark 'COSMO' under U.S. PTO registration No. 2305218. If none, please explain the basis Opposers decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with HCI's *Cosmopolitan* magazine, the abbreviation of HCI's COSMOPOLITAN mark to COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI's online content may be accessed. In addition, the registration referenced in Question No. 27 covers product design services for others, which are different from the goods and services offered by Opposer.

Question No. 28: Identify and describe all efforts by Opposers to prevent the entity known as Complete Business Solutions, Inc. 36205 W. Twelve Mile Road, Suite 250 Farmington Hills Michigan 48334-3339 and/or Covansys Corporation, 36205 W. Twelve Mile Road, Suite 250 Farmington Hills Michigan 48334-3339, from using and/or registering the mark 'COSMO' under U.S. PTO registration No. 2169138. If none, please explain the basis Opposers decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with HCI's *Cosmopolitan* magazine, the abbreviation of HCI's COSMOPOLITAN mark to COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI's online content may be accessed. In addition, the registration referenced in Question No. 28 covers computer consultation services for business and industry, which are different from the goods and services offered by Opposer.

Question No. 29: Identify and describe all efforts by Opposers to prevent the entity known as Draiswerke GmbH, Speckweg 43-51 D-68305 Mannheim, GERMANY and/or Buhler GmbH, 38114 Braunschweig, Germany, from using and/or registering the mark 'COSMO' under U.S. PTO registration No. 2179422. If none, please explain the basis Opposers [sic] decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with HCI's *Cosmopolitan* magazine, the abbreviation of HCI's COSMOPOLITAN mark to COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI's online content may be accessed. In addition, the registra-

tion referenced in Question No. 29 covers “agitator mill[s] used to grind and/or disperse solid particles in liquid vehicles for industrial process technology,” which are very different from the goods and services offered by Opposer.

Question No. 30: Identify and describe all efforts by Opposers to prevent the entity known as Cosmopolitan Textile Company, Road Five Industrial Estate Winsford Cheshire ENGLAND CW7 3QU, from using and/or registering the mark ‘COSMO’ under U.S. PTO registration No. 2557509. If none, please explain the basis Opposers [sic] decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with HCI’s *Cosmopolitan* magazine, the abbreviation of HCI’s COSMOPOLITAN mark to COSMO, and HCI’s COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI’s online content may be accessed. In addition, the registration referenced in Question No. 30 covers “non-woven stitch-bonded and knitted fleece fabrics for use in the automotive and luggage industries,” which are different from the goods and services offered by Opposer. Indeed, Opposer HCI and Cosmopolitan Textile Company previously have negotiated an agreement (the “Agreement”) to enable both parties to offer their respective products under their respective COSMOPOLITAN and COSMO marks in a manner that will not create confusion between Opposer HCI and Cosmopolitan Textile Company. Although the application underlying Registration No. 2557509 was filed prior to the executed Agreement, the resulting registration conforms to the terms of the Agreement.

Great care was taken by the parties to the Agreement in defining the goods on which Cosmopolitan Textile Company was permitted to use the mark, and the manner in which Cosmopolitan Textile Company was permitted to use the mark, to prevent consumer confusion. The Agreement further provides that both parties “will collaborate wherever necessary to take action as may be appropriate against unauthorised third party use of the trademarks.”

Question No. 31: Identify and describe all efforts by Opposers to prevent the entity known as Koh-i-noor Rapidgraph, Inc. 100 North St. Bloomsbury NJ 08804 and/or Cosmolab, Inc., 1100 Garrett Road Lewsburg Tennessee 37091, from using and/or registering the mark ‘COSMO’ under U.S. PTO registration No. 1045202. If none, please explain the basis Opposers decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers state that HCI initiated a cancellation action against Registration No. 1045202. The cancellation action alleged that the subject mark no longer was in use, and it was determined during discovery that the mark in fact was then in use. For this reason, Opposer HCI withdrew its petition to cancel the registration.

Question No. 32: Identify and describe all efforts by Opposers to prevent the entity known as Cosmo Instruments Co., Ltd. 2974-23, Ishikawa-cho, Hachioji Tokyo Japan, from using and/or registering the mark ‘COSMO’ under U.S. PTO registration No. 1459105. If none, please explain the basis Opposers decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix.

The underlying mark therefore does not inherently communicate to consumers familiar with HCI's *Cosmopolitan* magazine, the abbreviation of HCI's COSMOPOLITAN mark to COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI's online content may be accessed. In addition, the registration referenced in Question No. 32 covers air leak testers, which are different from the goods and services offered by Opposer.

Question No. 33: Identify and describe all efforts by Opposers to prevent the entity known as Cosmo Oil Co., Ltd. 1-1, Shibaura 1-chome Minato-ku, Tokyo 105 Japan, from using and/or registering the mark 'COSMO' under U.S. PTO registration No. 1696750. If none, please explain the basis Opposers decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with HCI's *Cosmopolitan* magazine, the abbreviation of HCI's COSMOPOLITAN mark to COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI's online content may be accessed. The mark underlying the registration also incorporates a prominent design element further distinguishing the mark from Opposers' marks. In addition, the registration referenced in Question No. 33 covers "petroleum, gasoline, fuel gas, industrial oil and lubricating oil," which are different from the goods and services offered by Opposer.

Question No. 34: Identify and describe all efforts by Opposers to prevent the entity known as Sanyo Tecnica USA, Inc. 7215 E 21 Street, Suite D, Indianapolis IN 46219, from using and/or registering the mark ‘COSMO’ under U.S. PTO registration No. 1977306. If none, please explain the basis Opposers decision to ignore such use.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with HCI’s *Cosmopolitan* magazine, the abbreviation of HCI’s COSMOPOLITAN mark to COSMO, and HCI’s COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI’s online content may be accessed. In addition, the registration referenced in Question No. 34 covers “radar detectors,” which are different from the goods and services offered by Opposer.

Question No. 35: Identify and describe all efforts by Opposers to prevent the entity known as Cosmo Corporation, 30201 Aurora Road, Cleveland OH 44139, from registering the mark ‘Cosmo’ under U.S. PTO registration No. 3035237. If none, please explain the basis for same.

Response: Opposers object to this question to the extent it seeks information not relevant to this litigation. Opposers additionally object to this question on the ground that the referenced registration is not evidence that the underlying mark actually is in use. Subject to these and the General Objections, Opposers have not taken any responsive actions because the referenced registration covers an underlying mark that does not include the .com suffix. The underlying mark therefore does not inherently communicate to consumers familiar with HCI’s *Cosmopolitan* magazine, the abbreviation of HCI’s COSMOPOLITAN mark to

COSMO, and HCI's COSMOPOLITAN.COM mark that the underlying mark has a corresponding website at which HCI's online content may be accessed. In addition, the registration referenced in Question No. 35 covers parts and services in the electrical and industrial fields, which are different from the goods and services offered by Opposer

Question No. 36: In light of the registration of the mark 'COSMO', by various third-parties as set forth in questions 20 - 31 [sic] above, and further, given Opposers' abandonment of its trademark, Registration No. 1843656, please explain the basis for Opposers' claim to superior rights the mark 'COSMO' sufficient to prevent registration of Applicant's application for Applicant's Mark.

Response: Opposers object to the characterization that they have abandoned the mark COSMO. As set forth above, the third party registrations referenced in many of Question Nos. 24-35 are of marks that do not include the .com suffix. These marks therefore do not inherently communicate to consumers familiar with HCI's *Cosmopolitan* magazine and the abbreviation of HCI's COSMOPOLITAN mark to COSMO that they have corresponding websites at which HCI's online content may be accessed. In addition, many of the registrations referenced in these questions cover different goods or services, and in at least one instance, the referenced registration already has been cancelled. Moreover, it is well-established that third party registrations such as those referenced by Applicant are not evidence of the actual use of the marks underlying those registrations or of the public's awareness of those marks. As a consequence, those registrations are not evidence of the weakness of HCI's marks nor are they indicative that Opposers do not maintain superior rights in the mark COSMO with respect to Applicant's Mark.

Question No. 37: Identify each expert that Opposers or any person acting for or on behalf of Opposers has consulted with or whose services have been retained with respect to any of the issues involved in this action, and for each, identify all documents upon which

said expert based his/her expert opinion, and specify the subject matter on which he/she was consulted or retained.

Response: Opposers have not retained an expert in this matter.

Question No. 38: Identify any and any searches, surveys, marketing studies or reports of any survey results relating to the mark COSMO or variants thereof), the uniform resource locator www.cosmo.com, that Opposers have ever conducted, caused to be conducted, has or had in its possession, including any searches, studies, surveys or the like relating to the availability and desirability of the designation COSMO and/or likelihood of confusion between the respective parties' marks or the marks of any other person or entity.

Response: Opposers object to this question to the extent that the question seeks the disclosure of information protected by the work product and the attorney-client privilege. Subject to these and the General Objections, Opposers state that there are no responsive documents.

Question No. 39: Identify and fully describe any and all instances of actual confusion of which Opposers are aware, resulting from the concurrent use by Opposers and Applicant of their respective marks.

Response: The evidence of actual confusion of which Opposers are aware has been submitted to the Board and to Applicant under cover of Opposers' First Notice of Reliance.

Question No. 40: Set forth the date that Opposers first learned of the existence of Applicant's use of COSMO, or Applicant's use of the uniform resource locator www.cosmo.com, and fully describe the circumstances of such event.

Response: Opposers first learned of Applicant's ownership of the www.cosmo.com domain name and of Applicant's establishment of an active website at that address in June 2000 when Opposers became aware of the filing of Applicant's application. It was only during discovery in this action and as a result of correspondence from Applicant's prior counsel that Opposers learned of Applicant's putative use of "Cosmo" as a nickname.

Question No. 41: Set forth the date that Opposers first learned of any third-parties use of the uniform resource locator www.cosmo.com, and fully describe the circumstances of such event.

Response: Opposers first learned of the domain name registration of www.cosmo.com by Applicant's predecessor in 1996, when Opposers researched the availability of various domain names for registration.

Question No. 42: Set forth the date Opposers first used the designation COSMO and the date first used in interstate commerce.

Response: Subject to the General Objections, Opposers refer Applicant to their response to Question No. 5.

Question No. 43: State whether Applicant [sic] has made continuous use of the term COSMO since the date stated in response to Question No. 42 and identify how Opposers made use of the designation COSMO, describing the manner of each such use.

Response: As previously stated, Opposers have been unable to identify the last use of the COSMO mark underlying Reg. No. 1843656 for the goods covered by that registration. However, Opposers' widespread and continued use of the COSMO mark in connection with *Cosmopolitan* magazine, departments and sections offered therein, web site content, special publications, and special events associated with or endorsed by Opposers has been uninterrupted.

Question No. 44: State the dates (if any) for which such use was interrupted and the reasons for interruptions of such use.

Response: Use of the COSMO mark underlying Reg. No. 1843656 has been discontinued; at this time, Opposers cannot identify the date such use was discontinued or the reasons therefor.

Question No. 45: Set forth the date that Opposers first conceived of the term COSMO for use in connection with Opposers' Goods and/or Services and describe in detail the circumstances by or under which Opposers first conceived of using the term COSMO in connection with Opposers' Goods and/or Services.

Response: The date of first use of the substantively identical COSMOPOLITAN mark by HCI's predecessor was 1886. Although Opposers believe that the actual date of use by the public of the COSMO mark to refer to Opposers' *Cosmopolitan* magazine occurred much earlier, Opposers have documented examples of such third party use as early as 1974. Use by HCI's predecessor of COSMO as a reference to *Cosmopolitan* magazine began at least as early as 1964.

Question No. 46: With respect to the date that Opposers first conceived of use of the term COSMO as stated in response to Question No. 45, state:

- a. The identity of the person(s) who conceived of such term;
- b. Whether the person(s), as identified in response to Question No 4I (a), were officers, employees, or representatives of, or were in any way affiliated with Opposers, and if so, identify the title, position or affiliations of each;
- c. From where such term was derived and the significance or meaning of the term COSMO;
- d. Describe in detail the process or method used by Opposers to select the designation COSMO or any mark(s) similar thereto for Opposers' goods and/or services; and
- e. The reasons for selection of such term.

Response: Subject to the General Objections, Opposers refer Applicant to their response to Question No. 5.

Question No. 47: State whether Opposers or any third party maintains a web site in connection with which Opposers' Goods and/or Services sold under the designation COSMO are promoted, advertised and/or otherwise referenced, and if so, identify:

- a. The domain name/address via which such web site can be accessed;
- b. The person or persons responsible for developing and maintaining each such web site; and
- c. The date that each such web site was developed and went "on-line."

Response: Opposers maintain web sites associated with the domains www.cosmopolitan.com and www.cosmomag.com. Subject to the General Objections, Opposers identify the following persons responsible for developing and maintaining these web

sites: Christie Griffin, Associate Editor/Web (January 30, 2006-present); Erin Torneo (commencing date unknown-December 15, 2005); and Heather Haber (dates unknown).

The domain www.cosmopolitan.com was registered on July 21, 1997, and the associated web site was developed and has been active since at least as early as December 1, 1998; the domain www.cosmomag.com was registered on October 19, 1995, and the associated web site was developed and has been active since at least as early as April 11, 1997.

Question No. 48: For each year, beginning with Opposers' date of first use of the designation COSMO, through the present, set forth a detailed list of all the goods and services as used in commerce in connection with which Opposers' use of the designation COSMO.

Response: In addition to the General Objections, Opposers object to this question on the ground that it is overly broad and unduly burdensome, calling for a detailed list by year of all the goods and services used in connection with Opposers' COSMO mark, the consuming public's designation for Opposers' *Cosmopolitan* magazine, in publication since the nineteenth century. Subject to these and the General Objections, Opposers refer Applicant to their response to Question No. 5.

Question No. 49: State whether Opposers have, at any time, licensed others or intends to license others to use term COSMO or any mark similar thereto, and if so, identify:

- a. The licensee(s);
- b. The periods of each such license;
- c. Each type of the goods and/or services involved in each such license;
- d. The amount of revenue generated from the sale of goods or services on which the licensed mark(s) have been used in commerce by each such licensee for each year each such license is or was in effect;
- e. The amount of revenue received by Opposers from each such license for
- f. each year each such license is or was in effect; and

- g. How Opposers controlled and/or controls the quality of the Licensee's publications, goods or services on which or in connection with Opposers' licensed marks are used.

Response: Opposers object to this question on the ground that it is overly burdensome and seeks information not relevant to this litigation. Opposers further object to this question to the extent it seeks information regarding revenue on the ground that such information is confidential. Subject to these and the General Objections, Hearst Magazines, a Division of Hearst Communications, Inc., granted to Cingular Wireless II, LLC a "Wireless Information Service Master Agreement (Linking)" (as referred to in this response, the "Agreement") licensing the COSMO mark to Cingular Wireless II, LLC for use in connection with wireless telecommunication services under the mark COSMO MOBILE. The license was granted effective October 2005 for an initial term of one year and automatically renews for further terms of one year each, and has not been terminated. The Agreement includes specific quality control provisions governing the license granted thereunder, including that any use must be approved prior to first use:

Prior to the first Use of [Opposers' Marks] in the manner permitted herein, [Cingular Wireless] must submit a sample of such proposed Use to [Opposers] for its prior written approval....

A copy of the Agreement is attached as Exhibit H.

Question No. 50: For each year, beginning with Opposers' date of first use of the designation COSMO, through the present, set forth the total amount of money that Opposers has spent on advertising of any goods and/or services under the designation COSMO.

Response: Subject to the General Objections, Opposers state that in 2005 alone, HCI and its licensees expended in excess of \$16,230,000 promoting the sale of goods and services under Opposers' family of COSMO and COSMOPOLITAN marks. In 1998, the year before the filing of Applicant's application, that figure was in excess of \$11,540,000.

Question No. 51: Identify all reports, memos, recommendations or opinions obtained by Opposers that relate, in any way, to the likelihood of confusion between Opposers' mark and Applicant's Mark.

Response: Subject to the General Objections, Opposers state that there are no responsive documents that are not protected from disclosure by the work product doctrine and the attorney-client privilege.

Question No. 52: If any question asks for information which could at some time have been answered by producing, consulting or referring to documents which are not longer in existence, identify each question for which that is the case and with respect to each such question:

- a. Identify what information was maintained;
- b. Identify all the type(s) of documents that contain such information;
- c. State the time period during which such documents were maintained;
- d. State the circumstances under which such documents ceased to exist;
- e. State the date when such documents cease to exist;
- f. Identify all persons having knowledge of the circumstances under which such documents ceased to exist; and
- g. Identify all persons who have knowledge or had knowledge of the documents and the contents thereof.

Response: Subject to the General Objections, Opposers state that the only specific information or documentation responsive to this question relates to a license agreement granted by Opposers for use of the COSMO mark in connection with leather goods. Opposers are unable to determine at this time whether the referenced license agreement has not yet been located or has been destroyed pursuant to The Hearst Corporation's Records Management Policy, a copy of which is attached as Exhibit I.

Question No. 53: Identify each and every person who assisted Opposers in answering these questions and/or provided documents or other things responsive to these questions and to Applicant's Request for Production of Documents served herewith.

Response: Opposers object to this question on the grounds that it does not relate to any issue raised by the testimony introduced by Opposers and therefore is not an appropriate

question for cross-examination. Opposers additionally object to this question on the ground that the question seeks information protected by the work product doctrine and the attorney-client privilege. Subject to this and the General Objections, Opposers state that the following employees of Opposers participated in the preparation of responses to Applicant's cross-examination:

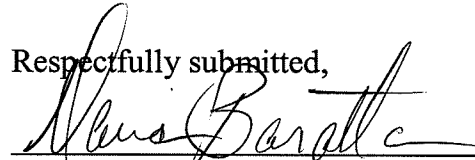
Stephen Rodgers

Peter Schmidt

Christie Griffin

Dated: September 11, 2006

Respectfully submitted,



Theodore H. Davis Jr.

Olivia Maria Baratta

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Attorneys for Applicant

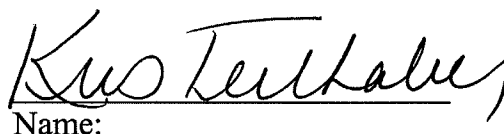
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hearst Communications, Inc. and)	
Hearst Magazines Property, Inc.,)	
)	
Opposers,)	
)	Opposition No. 91120453
v.)	
)	
Charles Browning Wilson,)	
)	
Applicant.)	

CERTIFICATE OF SERVICE

A copy of the attached document has been served on counsel for Applicant via first
class mail addressed to:

Robert M. Steckman, Esq.
The Law Office of Robert Steckman, P.C.
111 John Street, 8th Floor
New York, New York 10038


Name:

Date: September 11, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hearst Communications, Inc. and)	
Hearst Magazines Property, Inc.,)	
)	
Opposers,)	
)	Opposition No. 91120453
v.)	
)	
Charles Browning Wilson,)	
)	
Applicant.)	

**VERIFICATION OF OPPOSERS' RESPONSES AND OBJECTIONS
TO APPLICANT'S WRITTEN CROSS-EXAMINATION**

1. My name is Stephen Rodgers. I am Vice-President Administration of Hearst Magazines Division of Hearst Communications Inc. in this proceeding. The information set forth in this declaration is based upon my personal knowledge and upon documents maintained by employees within my supervision.

2. I have reviewed Opposers' Responses and Objections to Applicant's Written Cross-Examination originally filed on September 11, 2006. Subject to paragraph 3 below, I state that they are true and correct to the best of my knowledge.

3. By way of clarification, the following unregistered marks appeared only on the Cosmopolitan.com website, and not in the print version of the *Cosmopolitan* magazine as previously suggested by Opposers' Responses and Objections to Applicant's Written Cross-Examination and paragraphs 5 and 6 to the Second Declaration of Stephen Rodgers: COSMO SURVEYS, COSMO FAQs, COSMO KAMA SUTRA, COSMO FASHION, CONNECT WITH COSMO, BE IN COSMO, FREE STUFF FROM COSMO, COSMO EXCLUSIVES, GET COSMO HEADLINES, MAKE COSMO YOUR HOMEPAGE, TELL COSMO ABOUT YOUR

HAIR!, HELP COSMO CHOOSE ITS COVERLINES, MAKE A GREAT RECIPE FROM COSMO RADIO, SPORTING A STYLE YOU FOUND IN COSMO?, ADD COSMO TO YOUR MYSPACE, GET COSMO UPDATES, FREE STUFF FROM COSMO, COSMO MEDIA KIT, and EVERYTHING COSMO. The following unregistered marks have appeared as features in the print version of the *Cosmopolitan* magazine: COSMO QUIZ, COSMO FOR YOUR GUY, COSMO RADIO, COSMO PROMO HOT SPOT, COSMO HAIR, COSMO HOT SPOT, COSMO NEWS, GET MORE COSMO, COSMO GYNO, TOTALLY COSMO, COSMO INFORMER, THE COSMO POST, COSMO COMMANDMENTS, COSMO WEEKEND, COSMO MEN, and THE COSMO HEALTH REPORT.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, declares that the facts set forth in this declaration are true; all statements made of his or her own knowledge are true; and that all statements made on information and belief are believed to be true.



Stephen Rodgers

Date: Nov 30 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hearst Communications, Inc. and)	
Hearst Magazines Property, Inc.,)	
)	
Opposers,)	
)	Opposition No. 91120453
v.)	
)	
Charles Browning Wilson,)	
)	
Applicant.)	

CERTIFICATE OF SERVICE

I hereby certify that on this date, I served the foregoing **VERIFICATION OF OPPOSERS' RESPONSES TO APPLICANT'S WRITTEN CROSS-EXAMINATION** upon Applicant by depositing a copy thereof in the United States mail as first class mail, postage pre-paid, addressed as follows:

Robert M. Steckman, Esq.
The Law Office of Robert Steckman, P.C.
111 John Street, 8th Floor
New York, New York 10038

This the 3rd day of December, 2007.

/Lauren T. Estrin/
Lauren T. Estrin